

REMARKS

Claims 2, 12-16, 19, 20 and 21 are pending in the present application. Claim 2 has been amended. Claims 12-16 are withdrawn from consideration. Claims 1, 3-11, 17 and 18 are cancelled herein. New claims 19-21 have been added, support for which may be found in the prior claims.

Rejection under 35 U.S.C. §102

Claims 1, 3, 4, 5, 10 and 11 stand rejected under 35 U.S.C. §102(b) as being anticipated by the D2 reference.

Claims 1, 3, 4, 5, 10 and 11 have been cancelled herein. Thus, the outstanding rejection has been rendered moot. Withdrawal thereof is respectfully requested.

Rejections under 35 U.S.C. §103

Claims 2, 17 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over D2 in view of JP 2000333619 to Nobuyuki et al. (hereinafter "JP '619") and further in view of USP 4,671,957 to Holtshousen (hereinafter "Holtshousen").

P. temminckii frass is the excrement of larvae of *P. temminckii* which parasitizes bamboo.

As admitted by the Examiner in the last Office Action at page 5, lines 8-9, D2 does not disclose a skin cream for the prevention/treatment of pruritus caused by allergy.

JP '619 discloses using insect excrement within an antibacterial composition. The excrement, however, is that of stag beetle larvae, not *P. temminckii*, as required by the present invention. Stag beetle larvae live in, not bamboo, but rotted wood chips.

Holtshousen merely discloses that antibacterial cream may be used a skin topical.

In accordance with *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007), in formulating a rejection under 35 USC 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.

The Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336, quoted with approval in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1396 (2007)(emphasis added). A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)(emphasis in original).

Here, the Examiner has combined three unrelated prior art references in an attempt to obviate the claimed invention. However, such a combination can only be arrived at via impermissible hindsight. Whether an art is predictable or whether the proposed modification or combination of the prior art has a reasonable expectation of success is determined at the time the invention was made. *Ex parte Erlich*, 3 USPQ2d 1011 (Bd. Pat. App. & Inter. 1986)(emphasis added).

Moreover, with regard to the amounts of *P. temminckii* frass extract, the Examiner has taken the position that “the amounts of the frass extract are deemed to be manipulatable parameters practiced by a person skilled in the art to obtain the best possible formulations.” In short, the Examiner has made an optimization argument. However, “[a] particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.” *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). The Examiner has not specified that the amount of frass extract is a result-variable. Thus, the Examiner’s position regarding the amount of frass extract is improper.

In view of the foregoing, Applicants believe the pending application is in condition for allowance. A Notice of Allowance is earnestly solicited.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Monique T. Cole, Reg. No. 60,154 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By  #32868

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